

REMARKS

Numbering of Claims

The claims have been renumbered, as proposed by the Examiner, with claim dependencies corrected according to this renumbering in current amendments.

Claim Rejections 35 U.S.C. §112

The dependency of claim 54 has been corrected to be dependent on claim 46 addressing the indefiniteness objection.

Claim Rejections 35 U.S.C. §103

Thompson, Baar

Claims 46, 47, and 50-53 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Baar.

It is respectfully submitted that the combination of these references fails to teach all of the elements of claim 46 and thus a *prima facie* rejection has not been met. Specifically, neither Thompson nor Baar teach a "gasket formed of the same material as the ribs and extending along the underside of the lower rim and fused to the lower rim," where the term gasket is given its plain and ordinary meaning; a resilient material providing a seal between parts. Thompson implicitly provides a gasket inside the metal cap that is not positioned at the lower rim or joined to grip material. It is not apparent that Baar provides any gasket at all. Note that the "rim" is not any location on the cap but must be at the lower extent of the ribs by the express claim terms.

Thompson and Baar also fail to teach ribs that are "raised from the outer surface of the cap shell" also required by claim 46.

Thompson and Baar also fail to teach ribs that are "fused to the cap shell". Here the term "fused" is given its plain and ordinary meaning of "joined by melting" also required by claim 46. Note that claim terms such as "interbonded by interfusion", "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations. See MPEP §2113 citing In re Garnero.

The combination of Thompson and Baar also fails to teach express limitations of claim 51 requiring that "the pad and ribs are of the same material and the ribs join together at the pad." The ribs of Baar clearly do not join together in any manner, much less, at the upper pad. As Thompson does not even include ribs, it cannot teach ribs that join together at an upper pad.

The combination of Thompson and Baar also fails to teach or suggest the claim limitation of claim 53 in which the cap shell extends upward through the pad to present raised indicia. It is axiomatic that an anticipating reference must provide enablement for how to produce the claimed invention and these references provide no indication of how such a design would be produced much less suggest the design.

The Examiner suggests that the desire to make a cap easier to open, renders the present invention obvious, but this motivation is simply a hindsight acknowledgement of an advantage of the present invention's rib design. Neither Thompson nor Baar by their own terms suggests that their caps are insufficiently easy to open or that they could be improved with fused, raised, ribs. According to MPEP 2143.01, the prior art must suggest the desirability of the claimed invention, not just what is abstractly desirable.

There is also insufficient motivation to combine the references in the prior art or elsewhere, and the references, in fact, teach away from the combination proposed by the Examiner. The grip layer of Thompson could not have ribs formed in it and maintain the function as disclosed in Thompson, that of protecting the hand of someone opening the cap. Thompson describes spray coating a grip material, stretching an elastic ring, or using heat shrink material where a continuous outer surface is necessary for manufacture or to provide a force of retention. Putting ribs in the grip material would make application of the grip material in these ways impractical or impossible. An express object of the Baar invention is to recess the friction material in a groove. Whether this is for aesthetic reasons or functional reasons, the teaching of Baar are clearly counter to a design where ribs extend outward from the cap.

Walding, Baar

Claims 46-53 and 55-57 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Walding in view of Baar.

The combination of Walding and Baar, taken together, fail to teach express limitations of claim 46; therefore, a *prima facie* case of obviousness has not been established. Claim 46 requires "ribs fused to the cap shell and raised from the outer surface of the cap shell." The Baar reference clearly teaches recessed ribs, and Walding teaches no ribs. Neither reference is enabling with respect to how to produce raised ribs attached to the outer surface of the cap shell

by fusing. Only by hindsight reliance on the present application is there any indication that such a fusing could be practically accomplished for free standing ribs.

Claim 46 further requires that the ribs extend to the lower rim of the cap where they join to a gasket fused to that lower rim. This follows from the requirement that the ribs extend between the top wall and lower rim of the cap shell and that they attached to a gasket at the lower rim. As stated, the Walding reference has no ribs. Although Walding has a gasket, the gasket is not attached to the bottom of the ribs or to the lower rim of the cap shell as would be required by this claim. As noted above, the Baar reference does not show a gasket at all and the implicit gasket is separated from any possible connection with the outside of the cap.

The cited references further teach away from any modification that would produce the present structure. In Walding, attaching the lower end of the elastomeric material from the outside of the cap to the gasket would require running elastomeric material over the surface of the threads intended to hold the cap to a bottle, rendering the cap unsuitable for its intended function. Baar pointedly does not extend the friction material to the bottom of the cap and teaches manufacturing techniques that would be unsuitable for the structure proposed.

As before, the Examiner generally suggests that sufficient motivation for the modification of each of the above references to produce the present invention is a desire to make "opening and closing the cap easier." This is too broad a formulation of the law because it is a formulation that suggests any improvement in the ability to open a cap is obvious. The prior art must suggest the desirability of the structure of the claimed invention, not simply that the structure of the present invention viewed in hindsight produces a clearly desirable benefit.

In light of these amendments and remarks, it is believed claims 46-57 are now in condition for allowance, and allowance is respectfully requested.

Respectfully submitted,

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